

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants: Jay S. Walker, Jose A. Suarez, T. Scott Case, Michiko
Kobayashi, Andrew P. Golden
Application No.: 09/605,818
Filed: June 28, 2000
Title: SYSTEM FOR UTILIZING REDEMPTION INFORMATION
Attorney Docket No.: 00-001
Group Art Unit: 3625
Examiner: Mark A. Fadok

PETITION UNDER 37 C.F.R. §§ 1.181, 1.182

WITH

MEMORANDA TO SUPPORT THE PETITION

FOR

A REQUEST TO WITHDRAWAL AN IMPERMISSIBLE

SUPPLEMENTAL EXAMINER'S ANSWER

MS Petitions

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Appellants hereby petition, pursuant to MPEP § 1207.05(I) and 37 C.F.R. §§ 1.181, 1.182, for withdrawal of the Supplemental Examiner's Answer mailed on November 28, 2006 as Part of Paper No. 20061117 (hereinafter the "Supplemental Examiner's Answer").

**MEMORANDA IN SUPPORT OF THE PETITION FOR THE REQUEST TO WITHDRAWAL
AN IMPERMISSIBLE SUPPLEMENTAL EXAMINER'S ANSWER**

I. Applicable Authorities

Appellants are directed by MPEP § 1207.05(I) to file a petition under 37 C.F.R. § 1.181 to request withdrawal of a Supplemental Examiner's Answer that is believed to have been filed impermissibly. It also appears that the current issue may not be specifically provided for in the Rules and petition under 37 C.F.R. § 1.182 may therefore also or alternatively be appropriate.

II. Introduction

- Appellants filed an Appeal Brief on March 6, 2006 (hereinafter the "Appeal Brief"), a copy of which is attached hereto as Exhibit A, for convenience.
- The Examiner mailed an Examiner's Answer on June 15, 2006 (hereinafter the "Examiner's Answer"), in response to the Appeal Brief.
- Appellants filed, in response to the Examiner's Answer, a Reply Brief on August 15, 2006 (hereinafter the "Reply Brief"), a copy of which is attached hereto as Exhibit B, for convenience.
- The Examiner mailed a Notice of Reply Brief Noted on September 22, 2006, which was rejected by the Board of Patent Appeals and Interferences (BPAI) as constituting a Supplemental Examiner's Answer without the requisite signatory approval.
- The Examiner mailed the Supplemental Examiner's Answer, which is believed to be impermissible, on November 28, 2006.

III. **Facts**

The Examiner claims that the Supplemental Examiner's Answer is “compelled” due “to the entry of a substantial number of **new arguments**” presented in Appellants’ Reply Brief. Supplemental Examiner's Answer, pg. 2, second paragraph; emphasis added.

Appellants respectfully point out that “**new arguments**” in a Reply Brief are insufficient to warrant the filing of a Supplemental Examiner’s Answer. Specifically, a Supplemental Examiner’s Answer is only allowed in response to a Reply Brief if “**new issues**” are raised in the Reply Brief. 37 C.F.R. § 41.43(a)(1); MPEP §1207.05.

The following are examples of new issues raised in a reply brief that would give the examiner the discretion to provide a supplemental examiner's answer:

Example 1: The rejection is under 35 U.S.C. 103 over A in view of B. The brief argues that element 4 of reference B cannot be combined with reference A as it would destroy the function performed by reference A. The reply brief argues that B is nonanalogous art and therefore the two references cannot be combined.

Example 2: Same rejection as in example 1. The brief argues only that the pump means of claim 1 is not taught in the applied prior art. The reply brief argues that the particular retaining means of claim 1 is not taught in the applied prior art.

MPEP §1207.05(I)

In the present case, Appellants’ Reply Brief did not raise any “**new issues**”. Appellants’ Reply Brief did not, for example, present any arguments directed to any claim limitations not previously argued nor present any arguments directed to any elements of a claim limitation not previously argued. Instead, the Reply Brief was directed to answering various allegations made by the Examiner in the Examiner's Answer and to *reiterating arguments* presented in the Appeal Brief.

IV. Conclusion

At least for the above-stated reasons, Appellants respectfully request that the Supplemental Examiner's Answer be withdrawn as having been impermissible submitted.

V. Fees

Because this Petition may be considered appropriately filed under 37 C.F.R. § 1.182, the applicable fee from 37 C.F.R. § 1.17(f) of **\$400** is hereby authorized to be charged to Deposit Account No. 50-0271. Please charge any other fees that may be required for this Petition to Deposit Account No. 50-0271. Furthermore, while no petition for extension of time is believed to be required, should an extension of time be required, please grant any extension of time which may be required to make this Petition timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Appellants note that the submission of an impermissible Supplemental Examiner's Answer should constitute an error by the Office and accordingly, should this Petition be granted, Appellants hereby request that the above-mentioned fee be either waived or refunded, as appropriate.

Respectfully submitted,

December 18, 2006
Date

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